

REMARKS

Claims 1, 3, 4, 7-10, 13, 18, 20, 24-27, 35, 37-47, and 49-51 were under consideration. Applicants have cancelled claims 3, 4, 41, and 44, added new claims 52-60, and amended claims 1, 7-10, 13, 20, 24-27, 39, 40, 42, 43, and 45-47. Accordingly, claims 1, 7-10, 13, 18, 20, 24-27, 35, 37-40, 42-43, 45-47, and 49-60 are presented for consideration, of which claims 1, 20, 37, 38, 45, and 52 are independent.

Claims 1, 3, 4, 7, 18, 20, 24, 35, and 37-51 stand rejected under 35 U.S.C. § 102(b) as anticipated by Nardella (5,941,876). Applicants submit that these rejections are moot in light of the amendments. Nardella does not disclose or suggest at least a tip or distal portion including a “non-mechanically-cutting conducting portion and a non-conducting cutting edge” (claims 1, 20, and 45; see also claims 37 and 38; emphasis added). Further, Nardella does not disclose or suggest at least a tip “wherein all the cutting edges on the tip are non-conducting” (claim 52, emphasis added). Rather, Nardella describes the application of RF energy to an edge at scored ends 20 so as to create a high energy arc discharge that serves to sever or incise tissue (col. 3, lines 60-61; col. 7, lines 27-32 and 62-67; col. 8, lines 1-4). In particular, Nardella describes an auger bit implementation in which at least one cutting edge at scored end 20 is energized, and therefore conducting, and all the non-cutting portions are insulated, and therefore non-conducting (col. 3, lines 49-65; Fig. 1A). Nardella also describes another rotary cutter in which all the cutting edges of serrated opening 42 are energized, and therefore conducting (col. 4, lines 48-57; col. 7, line 60 - col. 8, line 4; Fig. 2A).

Therefore, for at least the reasons discussed above, independent claims 1, 20, 37, 38, 45, and 52, and all claims dependent therefrom, are not anticipated by Nardella.

Claims 1, 3, 4, 7, 18, 20, 24, 35, and 37-51 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Kresch (5,456,689). Applicants submit that these rejections are moot in light of the amendments. Kresch does not disclose or suggest at least “an electrical interface” and a tip or distal portion including a “non-mechanically-cutting conducting portion and a non-conducting cutting edge” (claims 1, 20, and 45; see also claims 37 and 38; emphasis added). Further, Kresch does not disclose or suggest at least “an electrical interface; and . . . a tip . . .

including a conducting portion and one or more cutting edges, wherein all the cutting edges on the tip are non-conducting" (claim 52). Rather, Kresch describes electrified embodiments having a cutting edge "which can resect either by conventional cutting or electrocautery," and therefore is conducting (col. 2, lines 25-28; see col. 4, lines 66-67 and Abstract at lines 12-13). Kresch also describes embodiments that do not include electrocautery (col. 6, lines 32-37), but Kresch does not disclose or suggest that these embodiments include an electrical interface, much less a non-mechanically-cutting conducting portion or a non-conducting cutting edge.

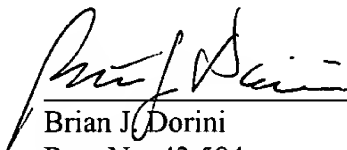
Therefore, for at least the reasons discussed above, independent claims 1, 20, 37, 38, 45, and 52, and all claims depending therefrom, are not anticipated by Kresch.

Applicants do not acquiesce to the Examiner's characterizations of the art. For brevity and to advance prosecution, however, Applicants have not addressed all of the characterizations but reserve the right to do so in further prosecution of this or a subsequent application.

Enclosed is a \$90.00 check for the excess claims fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: MAY 11, 2004



Brian J. Dorini
Reg. No. 43,594

Fish & Richardson P.C.
1425 K Street, N.W.
11th Floor
Washington, DC 20005-3500
Telephone: (202) 783-5070
Facsimile: (202) 783-2331